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10/623,603	07/22/2003	Haike Guan	R2180.0162/P162	5830
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DICKSTEIN SHAPIRO LLP			EXAMINER	
1825 EYE STREET NW			ROGERS, SCOTT A	
Washington, DC 20006-5403				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/623,603	GUAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Scott A. Rogers	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-59 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,10-19,21-30,32-41,43-52 and 54-59 is/are rejected.
- 7) Claim(s) 6-9,20,31,42 and 53 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/22/2003.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: Detailed Action (p. 2-8).

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-11, 17-19, 21-22, 28-30, 32-33, 39-41, 43-44, 50-52, and 54-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above dependent claims all have improper antecedent basis for the limitations therein, as noted below, due to what appears to be simply an error in claim dependency, also as noted below.

Claims 17-19, 28-30, 39-41, and 50-52 all recite the “quantitative characteristic of the background dot pattern” for which there is no antecedent basis. These claims should depend from claims 16, 27, 38, and 49 respectively. Note claims 6-8 correctly depend from claim 5.

Claims 10-11, 21-22, 32-33, 43-44, and 54-55 all recite the “detected first background dot pattern is determined as substantially identical to . . .” for which there is no antecedent basis. These claims should depend from claims 9, 20, 31, 42, and 53 respectively.

Note claims 4, 15, 26, and 37 do not have a claim dependency problem, but applicant may have intended these claims to depend from independent claims 1, 12, 23, and 34 respectively. Note claim 48 is dependent from independent claim 45.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 34-44 and 58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 34-44 and 58 define a computer program product stored on a computer readable storage medium

embodying functional descriptive material. However, the claims do not define a computer-readable medium or memory as the product and are thus non-statutory for that reason. Even though the program is stored on a computer readable medium, it is the program itself that is being claimed as the product (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the functional descriptive material must be structurally and functionally interrelated to the computer readable medium. In order to make the claim statutory, the examiner suggests alternatively amending the claims to set forth a "computer readable medium" or equivalent embodying a program executed on a computer. Any amendment to the claims should be commensurate with its corresponding disclosure.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 12-14, 23-25, 34-36, 45-47, and 56-59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,901,236. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are broader than the patent claims and are therefore anticipated.

Claims 1-4, 12-15, 23-26, 34-37, 45-48, and 56-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 120-122, 124, 126, 128, 130, 134-136, 138, 142-144, and 146-147 of copending Application No. 10/982,976. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are broader than the patent claims and are therefore anticipated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 12-14, 23-25, 34-36, 45-47, and 56-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-49 of copending Application No. 10/992,924. Although the conflicting

claims are not identical, they are not patentably distinct from each other because the application claims are broader than the patent claims and are therefore anticipated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 12-14, 23-25, 34-36, 45-47, and 56-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 10/738,139. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are broader than the patent claims and are therefore anticipated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 12-14, 16, 23-25, 27, 34-36, 38, 45-47, 48, and 56-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsunoshita (US 7227661 B2).

Referring to claims 1, 12, 23, 34, and 45:

Matsunoshita discloses storing an anti-copy background dot pattern (reference patterns of Figs. 5D and 5E); providing image data of an original image (input to part 220); detecting a first background dot pattern embedded in a background image included in the image data of the original image (function of part 224); comparing the detected first background dot pattern with the stored anti-copy background dot pattern (function of part 224); and determining whether the detected first background dot pattern is substantially identical to the stored anti-copy background dot pattern (function of part 236. See Fig. 8-9 and col. 17, line 34 to col. 18, line 30 and col. 19, line 50 to col. 22, line 9.

Referring to claims 2-3, 13-14, 24-25, 35-36, and 46-47:

Matsunoshita discloses the image data is data obtained by a reading of the original image with an original reading apparatus, wherein the original reading apparatus is a scanner included in an image processing apparatus. See scanning part 5.

Referring to claims 5, 16, 27, 38, and 49:

Matsunoshita discloses comparing a quantitative characteristic of the detected first background dot pattern with a quantitative characteristic of the anti-copy background dot pattern. See col. 20, line 35 to col. 21, line 37.

Referring to claims 56-59:

Matsunoshita discloses the first background dot pattern is generated together with the original image. See image generated by image composing part 522.

***Allowable Subject Matter***

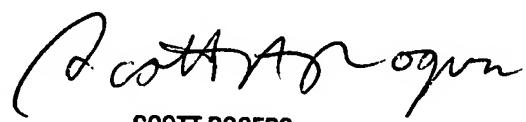
Claims 6-9, 20, 31, 42, and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Rogers whose telephone number is 571-272-7467. The examiner can normally be reached Monday through Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached at 571-272-7402.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service at 571-272-2600. Official correspondence by facsimile should be sent to 571-273-8300. The USPTO contact Center phone numbers are 800-PTO-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SCOTT ROGERS  
PRIMARY EXAMINER